



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,077	02/20/2004	Thomas V. Prendergast	2003P04405 US01	6273

7590 03/19/2009
Alexander J. Burke
Intellectual Property Department
5th Floor
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

WOODS, TERESA S

ART UNIT	PAPER NUMBER
----------	--------------

4114

MAIL DATE	DELIVERY MODE
-----------	---------------

03/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,077	Applicant(s) PRENDERGAST, THOMAS V.	
	Examiner TERESA WOODS	Art Unit 4114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 02/20/2004.
2. Claims 1-26 are currently pending and have been examined.

Claim Rejections - 35 USC § 112, 2nd Paragraph

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for the lack of antecedent basis. Claim 19 reads *wherein the step of identifying a particular document comprises the step of identifying a particular type of the particular document*. Does this mean having particular steps that lead to retrieving a particular insurance claim document?

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-26 are rejected under 35 U.S.C. 101 because there is no machine tied to the method along with no physical transformation being produced.
6. Claims 1-26 are rejected under 35 U.S.C. 101 because the claims are directed towards a system of processing, but do not claim any software, graphical user interface (GUI) or word processor tied to the system along with a physical transformation needed to produce documents.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5, 7, 9, 10, 11, 13, 16, 24, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Provost (US 7,263,493 B1).

9. **Claim 1:**

Provost, as shown, discloses the following limitations:

- *an interface processor for receiving claim data related to a claim for provision of a service to a particular patient (see at least column 19, lines 59-67);*
- *an attachment processor for automatically applying predetermined claim submission requirements in processing said claim data to identify (see at least Fig. 5, column 18, lines 38-52):*

In this citation, Provost's server system automatically prompts the user that attachments are required. These attachments are Provost's supporting documents needed to further process the insurance claim.

- *whether an attachment document is required to be submitted together with said claim to a payer for claim reimbursement; and (see at least column 3, lines 55-60, column 7, lines 7-19)*

In the first citation, Provost's server system shows the ability to attach supporting documents required to further process the insurance claim. The second citation shows communication with the server system and a local client system, which serve as the payer.

- *a particular document to be provided together with said claim to said payer for claim reimbursement; and (see at least column 3, lines 55-57)*

- *a document processor for retrieving said particular document from storage for provision to said payer for claim reimbursement (see at least column 3, lines 60-65).*

In the citation, Provost's list that defines the supporting documents server as the provisioning to the stored particular document required to further process the insurance.

10. Claim 2:

Provost, as shown, discloses the following limitations:

- *wherein said document processor automatically initiates communication of said particular document to said payer by electronic communication including at least one of, (a) Facsimile transmission, (b) Email, (c) Internet compatible communication and (d) a transaction standard compatible communication (see at least Fig. 2, column 15, lines 63-65).*

Provost's system is intended to be used over the internet.

11. Claim 3:

Provost, as shown, discloses the following limitations:

- *wherein said electronic communication includes encryption of said particular document prior to communication (see at least column 16, lines 33-36).*

12. Claim 5:

Provost, as shown, discloses the following limitations:

- *wherein said attachment processor automatically identifies a particular type of said particular document to be provided together with said claim to said payer for claim reimbursement (see at least Fig. 2, Fig. 5 column 3, lines, 55-65, column 18, lines 38-52)*

In this citation, Provost's server system automatically prompts the user that attachments are required. Also, Provost's list defining the supporting document is the plurality of documents supporting documents needed to further process the insurance claim.

13. Claim 7:

Provost, as shown, discloses the following limitations:

- *wherein said attachment processor processes said claim data to derive information including at least one of (a) diagnosis information, (b) medical procedure information and (c) charge information, related to said claim, and employs said derived information in determining whether an attachment document is required to be submitted together with said claim to a payer for claim reimbursement (see at least Fig. 4, column 10, lines*

57-65).

14. Claim 9:

Provost, as shown, discloses the following limitations:

- wherein said document processor determines said particular document is unavailable from storage and initiates generation of said particular document using information derived from at least one of, (a) a clinical data repository, (b) a laboratory results repository and (c) an electronic patient record of said particular patient (see at least Fig. 2, column 10, lines 4-11).

15. Claim 10:

Provost, as shown, discloses the following limitations:

- *said attachment processor compiles a map associating a particular claim with one or more required attachments and updates said map in response to identifying said particular document is to be provided together with said claim to said payer for claim reimbursement.*

In Provost's Fig. 5, items 86, 88, 92, 96, 98 and 104, under the server decision tree, the required mapping involved with updating a claim with attached supporting documents are required to further process an insurance claim.

16. Claim 11:

Provost, as shown, discloses the following limitations:

- *11. A system according to claim 10 wherein said predetermined claim submission requirements comprise rules which associate claim data indicating provision of a service of a particular nature with an attachment and particular document (see at least Fig. 2, column 14, lines, 1-22).*

In the citation, Provost's has required rules associated with advancing claim payment funds. The second citation, list defining the supporting document is the plurality of documents supporting documents needed to further process the insurance claim.

17. Claim 13:

Provost, as shown, discloses the following limitations:

- *said attachment processor automatically applies said predetermined claim submission requirements in processing said claim data to identify a plurality of documents to be provided together with said claim to said payer for claim reimbursement, and (see at least Fig. 2, Fig. 5 column 3, lines, 55-65, column 18, lines 38-52)*

In this citation, Provost's server system automatically prompts the user that attachments are required. Also, Provost's list defining the supporting

document is the plurality of documents supporting documents needed to further process the insurance claim.

- *said document processor retrieves said plurality of documents from storage for provision to said payer for claim reimbursement (see at least column 3, lines, 55-65).*

In the citation, Provost's list defining the supporting document is the plurality of documents supporting documents needed to further process the insurance claim.

18. Claim 16:

Provost, as shown, discloses the following limitations:

- *further comprising the step of automatically initiating communication of said particular document to said payer by electronic communication including at least one of, (a) Facsimile transmission, (b) Email, (c) Internet compatible communication and (d) a transaction standard compatible communication (see at least Fig. 2, column 15, lines 63-65).*

Provost's system is intended to be used over the internet.

19. Claim 24:

Provost, as shown, discloses the following limitations:

- *compiling a map associating a particular claim with one or more required attachments; and (see at least Fig. 5, column 18, lines 38-47)*
- *updating said map in response to identifying said particular document is to be provided together with said claim to said payer for claim reimbursement (see at least Fig. 5, column 18, lines 47-56).*

In Provost's Fig. 5, items 86, 88, 92, 96, 98 and 104, under the server decision tree, the required mapping involved with updating a claim with attached supporting documents are required to further process an insurance claim.

20. Claim 25:

Provost, as shown, discloses the following limitations:

- *automatically applying said predetermined claim submission requirements in processing said claim data for the purpose of identifying a plurality of documents to be submitted together with said claim to said payer for claim reimbursement, and (see at least Fig. 2, Fig. 5 column 3, lines, 55-65, column 18, lines 38-52)*

In this citation, Provost's server system automatically prompts the user that attachments are required. Also, Provost's list defining the supporting document is the plurality of documents supporting documents needed to further process the insurance claim.

- *retrieving said plurality of documents from storage for provision to said payer for claim reimbursement (see at least column 3, lines, 55-65).*

In the citation, Provost's list defining the supporting document is the plurality of documents supporting documents needed to further process the insurance claim.

21. Claim 26:

Provost, as shown, discloses the following limitations:

- *receiving data related to a claim for provision of a service to a particular customer (see at least column 19, lines 59-67);*

In the citation, Provost's carrier associated with the insurance claim would be considered a particular customer.

- *processing said data by automatically applying predetermined claim submission requirements for the purpose of (see at least Fig. 5, column 18, lines 38-56):*

In the citation, Provost's notification to deliver required documentation is used to further process a claim as an automatic submission requirement.

- *identifying whether an attachment document is required to be submitted together with said claim to a payer for claim reimbursement; and (see at least column 3, lines 55-60)*
- *identifying a particular document to be provided together with said claim to said payer for claim reimbursement; and (see at least column 3, lines, 48-65)*
- *retrieving said particular document from storage for provision to said payer for claim reimbursement (see at least column 3, lines, 48-65)*

In the citation, Provost's supporting documents are the particular attached documents and insurance carrier is the payer.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. Claims 4, 6, 8, 12, 15, 18, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost (US 7,263,493 B1) in view of Constantin (US 7,154,622 B2).

25. **Claim 4:**

Provost discloses the limitations as shown in the rejections above. Provost does not disclose the following limitation, but Constantin discloses *wherein said attachment processor automatically identifies a particular version of said particular document to be provided together with said claim to said payer for claim reimbursement* (see at least column 9, lines 10-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Provost's system for attaching insurance documents with Constantine's appropriate prior approval forms as one of the particular documents needed to process a medical insurance claim payment to provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

26. Claim 6:

Provost discloses the limitations as shown in the rejections above. Provost does not disclose the following limitation, but Constantin discloses *wherein said particular type includes one of (a) a receipt, (b) a photograph, (c) a chart, (d) an invoice, (e) a certificate, and (f) a prescription* (see at least column 4, lines 27-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Provost's system for attaching insurance documents with Constantine's ability to generate an invoice, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

27. Claim 8:

Provost discloses the limitations as shown in the rejections above. Provost does not disclose the following limitation, but Constantin discloses *wherein said document processor determines said particular document is unavailable from storage and initiates generation of said particular document* (see at least column 4, lines 33-36, column 9, line 61 to column 10, line 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Provost's system for attaching insurance documents with Constantine's ability to generate a particular missing document, because it would provide a more

comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

28. Claim 12:

Provost discloses the limitations as shown in the rejections above. Provost does not disclose the following limitation, but Constantin discloses *wherein said predetermined claim submission requirements comprise rules which associated one of more of: (a) a laboratory receipt with a claim for reimbursement for a laboratory test; (b) an X-ray with a claim for reimbursement for setting a broken bone; (c) a prescription with a claim for reimbursement for providing medication; a receipt with a claim for reimbursement for services provided by an outside organization* (see at least column 9, lines 20-23). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Provost's system for attaching insurance documents with Constantine's ability to submit x-rays, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

29. Claim 15:

Provost, as shown, discloses the following limitations:

- *receiving claim data related to a claim for provision of a service to a particular patient (see at least column 19, lines 59-67);*
- *processing said claim data by automatically applying predetermined claim submission requirements for the purpose of (see at least Fig. 2, column 7, lines 49-62):*
- *identifying whether an attachment document is required to be submitted together with said claim to a payer for claim reimbursement; and (see at least column 3, lines, 55-60)*
- *identifying a particular document to be provided together with said claim to said payer for claim reimbursement; and (see at least column 3, lines, 48-57)*
- *retrieving said particular document from storage for provision to said payer for claim reimbursement (Con, see at least column 4, lines 30-38).*

30. Claim 18:

Provost discloses the limitations as shown in the rejections above. Provost does not disclose the following limitation, but Constantin discloses *wherein the step of identifying a particular document comprises the step of identifying a particular version of the particular document (see at least column 9, lines 17-20,*

column 9, line 61 to column 10, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Provost's system for attaching insurance documents with Constantine's ability to identify a particular document, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

31. Claim 19:

Provost discloses the limitations as shown in the rejections above. Provost does not disclose the following limitation, but Constantin discloses *wherein the step of identifying a particular document comprises the step of identifying a particular type of the particular document* (see at least column 9, lines 17-20, column 9, line 61 to column 10, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Provost's system for attaching insurance documents with Constantine's ability to identify a particular document, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

32. Claim 22:

Provost discloses the limitations as shown in the rejections above. Provost does not disclose the following limitation, but Constantin discloses:

- *determining if said particular document is available in said storage; and*
(see at least column 4, lines 9-12)
- *generating said particular document if said particular document is not available in said storage* (see at least column 4, lines 30-38).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Provost's system for attaching insurance documents with Constantine's ability to generate a particular missing document, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

33. Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost (US 7,263,493 B1) in view of Official Notice

34. Claim 14:

Provost, as shown, discloses the following limitations:

- *an interface processor for receiving data related to a claim for reimbursement for provision of a service to a customer (see at least Fig. 2, column 3, lines 52-58, column 7, lines 42-46);*
- *an attachment processor for automatically applying predetermined claim submission requirements in processing said claim data to identify (see at least Fig. 2, column 7, lines 50-52):*
- *whether an attachment document is required to be submitted together with said claim to a payer for claim reimbursement; and (see at least column 3, lines 55-60)*
- *a particular document to be provided together with said claim to said payer for claim reimbursement; and (see at least column 3, lines 60-65)*

Provost discloses the limitations mentioned above. Provost does not disclose the limitations mentioned below. However, the Examiner takes **Official Notice** that it is old and well-known in the medical insurance arts that whatever required supporting documents can be stored, retrieved and attached with the claim to process an insurance payment. It would have been obvious to a person having ordinary skill in the art at the time of invention to combine *a document processor for retrieving said particular document from storage for provision to said payer for claim reimbursement* with Provost's system for attaching insurance documents with Constantine's ability to retrieve particular documents from,

because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

35. Claim 21:

Provost, as shown, discloses the following limitations:

- *employing said derived information to determine whether an attachment document is required to be submitted together with said claim to a payer for claim reimbursement (see at least Fig. 5, column 18, lines 14-41).*

Provost discloses the limitations mentioned above. Provost does not disclose the limitations mentioned below:

- *processing said claim data comprises the step of deriving information including at least one of (a) diagnosis information, (b) medical procedure information and (c) charge information, related to said claim; and (ON).*

However, the Examiner takes **Official Notice** that it is old and well-known in the medical insurance arts that whatever required supporting documents can be stored, retrieved and attached with the claim to process an insurance payment. It would have been obvious to a person having ordinary skill in the art at the time of invention to combine *a document processor for retrieving said particular document from storage for provision to said payer for claim reimbursement* with Provost's system for attaching insurance documents with the

ability to process medical diagnosis information, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

36. Claims 17, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost (US 7,263,493 B1) in view of Official Notice further in view of Constantin (US 7,154,622 B2).

37. **Claim 17:**

Provost discloses the limitations as shown in the rejections above. Provost and Official Notice do not disclose the following limitation, but Constantin discloses *further comprising the step of encrypting said particular document before initiating communication* (see at least column 4, lines 54-66). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Official Notice and Provost's system for attaching insurance documents with Constantine's ability to encrypt certain documents before submitting, because it would help to avoid insurance fraud. This would improve the integrity of the insurance carrier and medical health care providers.

38. Claim 20:

Provost discloses the limitations as shown in the rejections above. Provost and Official Notice do not disclose the following limitation, but Constantin discloses *wherein the step of identifying a particular type of the particular document comprises identifying the particular type as one of (a) a receipt, (b) a photograph, (c) a chart, (d) an invoice, (e) a certificate, and (f) a prescription* (see at least column 4, lines 27-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Official Notice and Provost's system for attaching insurance documents with Constantine's ability to generate an invoice, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

39. Claim 23:

Provost and Official Notice disclose the limitations as shown in the rejections above. Provost and Official Notice do not disclose the following limitation, but Constantin discloses:

- *deriving information from at least one of (a) a clinical data repository, (b) a laboratory results repository and (c) an electronic patient record of said particular patient* (see at least column 9, lines 26-31);

- *and generating said particular document using the derived information*
(see at least column 4, lines 30-38).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Official Notice and Provost's system for attaching insurance documents with Constantine's ability to retrieve a patient's medical records and generate a particular document, because it would provide a more comprehensive claim filling system. This would help to reduce the time needed process a medical insurance claim payment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Teresa Woods** whose telephone number is **571.270.5509**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jerry O'Connor** can be reached at **571.272.6787**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to **(571) 273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/TERESA WOODS/
Examiner, Art Unit 4114
03/04/09

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686